

REMARKS

The last Office Action dated 9/22/2005 has been carefully considered. It is noted that Claims 12-20 have been cancelled in response to the Examiner's restriction requirement. It should be noted that the Notice Requiring Excess Claim Fees dated 12/21/2005 is now moot in light of the Applicant's cancellation of claims 12-20.

It is noted that Claims 6 and 7 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is believed that the above amendments to the claims are fully responsive to the Examiner's rejection, in that Claims 6 and 7 have been amended to correct the Examiner's specific grounds of rejection.

It is further noted that Claims 1, 2, 10 and 11 have been rejected under 35 U.S.C. § 102(b) as being unpatentable over Lanigan et al. (U.S. Pat. No. 3,837,330)

It is also noted that Claims 1, 5, 10 and 11 have been rejected under 35 U.S.C. § 102(b) as being unpatentable over Eide (GB Pat. No. 2 034 173A, June 4, 1980)

It is further noted that Claims 3 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lanigan et al. in view of Kuhn (U.S. Pat. No. 4,790,292).

Additionally, it is noted that Claims 6 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lanigan et al. in view of Groll (U.S. Pat. No. 6,267,830). The Examiner has also rejected claims 6 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Eide et al. in view of Groll.

Further, it is noted that Claim 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lanigan et al. in view of Groll (U.S. Pat. No. 6,267,830), and Kim (U.S. Pat. Application No. 2003/0160053 A1, Aug. 28, 2003). The Examiner has also rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Eide et al. in view of Groll, and further in view of Kim.

Finally, it is noted that Claims 9 is rejected under 35 U.S.C. § 103(a) as being

unpatentable over Lanigan et al. in view of Ulam (U.S. Pat. No. 4,646,935). The Examiner has also rejected claim 9 under 35 U.S.C. §103(a) as being unpatentable over Eide et al. in view of Ulam.

The Applicant disagrees with the Examiners position on the rejections of claim 1, 2, 10 and 11 as being anticipated by the Lanigan reference.

First, Lanigan is an improper reference as it is not analogous art under the authority of *In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (C.C.P.A. 1979). *In re Woods* held that "*The determination that a reference is from a nonanalogous art is therefore two-fold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.*"

The Applicants field of endeavor is cookware, that is utensils and vessels used to actually cook food. Lanigan is carrier device for transporting a serving plate from the kitchen or food preparation area to the diner's seat at the table. Lanigan's invention is actually unfit for cooking for multiple reasons. It should be noted that Lanigan's device has a central aperture or single opening 17 in the heat retention ember 13. which Lanigan teaches is an advantage of his invention. This aperture, when also combined with strong curvature of the bottom surface 12c, and the widely variable thickness of heat conduction member 13 would lead to a severe temperature gradient across the bottom of the dish, leading to the non-uniform cooking of foodstuff.

Lanigan's invention is not reasonably pertinent to the applicant's invention because it attempts to solve the problem of cooked food cooling off or chilling before it can be served in a completely different manner than the Applicant. The Applicant's invention is an improvement in an insulated cooking vessel, where the loss of heat by so much as transferring the food from the cookware is avoided. In contrast, Lanigan's invention requires the transfer of food after cooking to a serving dish (as the vessel disclosed by Lanigan is unfit for cooking) causing an initial loss of heat that the Applicant's invention avoids. More specifically, Lanigan's invention is shaped to receive a standard serving plate, and not configured for cooking foodstuffs. Further, Lanigan's invention subjects

the food to an initial loss of heat from cooking when it is transferred from the cooking vessel to a serving plate. Lanigan then deploys a preheated heat retaining block to prevent further loss of heat as the server plate is moved to the individual diner. In contrast, the Applicant's invention is cookware intended for dual use as serving vessels the metal in the cooking vessel is already hot, the intent is to prevent loss of heat to the food as the metal cools and then acts as a thermal conductor to cool the food further. In contrast, in the field of use of Lanigan, the cooked food is already placed on a a generally ceramic or possibly glass serving plate, which is then placed in Lanigan's serving dish. As glass and ceramics are poor thermal conductors relative to metal in the original cookware, and entirely different problem is faced. The problem faced by the Applicant and others innovating in the field of cookware is that because the cooking vessel is a good conductor, for cooking efficiency it will also be a good conductor of heat away from the food after the cooking is finished but before it is served. Accordingly, the Lanigan reference is not reasonably pertinent.

In *arguendo*, it is further submitted Lanigan does not teach every element and limitation of claim 1 as is required to reject a claim under §102. The Examiner has mischaracterized the Lanigan reference in that it does not teach or suggest what the Applicant has claimed. The Examiner's statement in paragraph 12 of the office action that "*the thermally conductive medium extends over the bottoms of the inner and outer vessels and upward to partially fill the void between the vessels*" reads on the Applicant's specification, and has no factual support in the reference. FIG. 1 of Lanigan clearly shows, as highlighted in the attachment labeled EXHIBIT 1, that heat retention member 13 does not extend upward to partially fill the void between the walls, because the area between the walls must include the inner wall 15 and the outer wall 12. Inner wall 15 only extends upward from inner bottom surface 11b, however the top of heat retention block 13 is flush with the top of block 13! Moreover, Lanigan makes this quite clear in column 4, lines 29 to 33 in which he states that "*the heat retention member ...has a top surface substantially co-extensive with the flat top wall portion 11b of the shell..*"

Accordingly, as the Examiner's rejection of Claim 1 based on Lanigan cannot be sustained on either of the above grounds, it is specifically requested to now be

withdrawn. As Claims 2, 10 and 11 depend from Claim 1, the rejections under §102(b) should likewise be withdrawn.

The Applicant further disagrees with the Examiner's position on the rejections of claim 1, 5, 10 and 11 as being anticipated by the Eide reference. Again, the Examiner has mischaracterized the Eide reference to read on the Applicant's limitation in Claim 1. As further clarified in EXHIBIT 2, the cavity (referred to interspace 20 by Eide) is not partially filled with the thermally conductive material as defined by the Claim 1. The claim requires that the vertical space between the vertical walls of the vessel be partially filled. Specifically, the amended claims contain the express limitation that “.. cavity remains in the vertical space between the vertical walls of the inner and outer vessel above the partially filled portion.” The cavity in Eide's interspace 20 is not above the thermal conductive material (core sheet 10), but vertically disposed along side it. As the core sheet 10 is Eide is continuous, extending upward along the entire vertical height of inner space 20, the cavity cannot be above the partially filed portion (equivalent to core sheet 10). The Applicant is amending claim 1 to further clarify this distinction for the Examiner, and does not intend to limit the scope in the originally filed application.

Accordingly, the Examiner's rejection of Claim 1 cannot be sustained, and is specially requested to now be withdrawn, as Eide does not teach every element and limitation of claim 1. As Claims 5, 10 and 11 depend from Claim 1, the rejections under §102(b) should likewise be withdrawn.

As to the rejection of remaining claims 3, 4, 6, 7, 8 and 9 rejected under §103, the Examiner has the burden to show that each element and claim limitation can be found in the combination of references. As the remaining claims depend from claim 1, they incorporate limitations discussed above not found in the in Eide or Lanigan. Hence, the Examiner has failed to establish a *prima facie* case of obviousness with respect to these dependent claims, as they incorporate through claim 1 limitations not found in any cited reference.

The Applicant wishes to remind the Examiner that he carries the burden to indicate with specificity the teaching, suggestion or motivation to modify the reference as well as

combine the elements in the cited references, as stated in *McGinley v. Franklin Sports Inc.*, 262 F.3d 1339, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) which held that “*The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some "teaching, suggestion or reason" to combine cited references.*” *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). “*When the art in question is relatively simple, as is the case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously.*”

The Courts have emphasized and amplified on this rule in numerous decisions, for example see *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) (“*a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'*”) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“*Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.*”); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (*there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant*); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (“*teachings of references can be combined only if there is some suggestion or incentive to do so.*”)(emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

Further, it is respectfully submitted, *in arguendo*, that even if the Examiner could establish a prima facie case of obviousness using the either the Lanigan or the Eide reference, it is the Applicant’s position that it is rebutted by the references themselves teaching away from the claimed combination. Under *McGinley v. Franklin Sports Inc.*, 1010, *supra*, it was held that “We have noted elsewhere., as a “useful general rule”, that

references that teach away cannot serve to create a *prima facie* case of obviousness".

Specifically, the Lanigan reference teaches away from claimed invention at column 3, lines 25-29. Specifically, "*It was observed that the heat-retention member occupies substantially all of the space between the shells*".

Further, Eide also teaches away from the applicant's invention in that core sheet 10 must extend the entire vertical height of the outer sidewall 11 such that rim 13 can be formed and sealed in the process disclosed. The Applicant utilizes a totally different process that obviates the limitation that core layer 10 be contiguous and extending upward the entire length of outer wall 11 or inner wall 10.

New claim 21 is provided to further distinguish between the Applicant's invention and what is disclosed in the Eide and Lanigan patents. Claims 22 to 31 depend from claim 21. It is respectfully submitted that the new claims 21-31 clearly and patentably distinguish over the prior art, since it is believed that the construction defined in these claims differs essentially and in an unobvious, highly advantageous manner from the constructions disclosed in the references. The Applicant believes that combining the references discussed above would not lead to the claimed invention, in that the present invention does not merely employ the known substitution of equivalents but rather employs a new, non-obvious combination to accomplish the objectives set out in the present application.

As for the proposed combination of references cited by the Examiner, it is respectfully submitted that since none of the references in the combination teaches the distinctive features of applicant's invention as defined now in the new claims 21-31, any hypothetical construction produced by this combination would not lead to applicant's invention.

It is respectfully submitted that the combined teachings of the references applied by the Examiner fail to disclose or even suggest the subject matter of the claims at issue. That a prior art reference could be modified to form the claimed structure does not supply a suggestion to do so. "*The mere fact that the prior art could be so modified would not*

have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

In view of these considerations, it is respectfully submitted that the rejection of the original claims should be considered as no longer tenable with respect to the revised claim 1 and the remaining dependent claims 2-11, and the rejections should be withdrawn. The new claims 22-31 should also be considered as patentably distinguishing over the art and should be allowed.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned.

Respectfully submitted:

by:  on 1/6/2006

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